

REMARKS

Applicants have carefully considered the December 20, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-16 were pending in this application. In response to the Office Action dated December 20, 2004, claims 1-4 and 14 have been amended. New claim 24 has been added. Claim 16 has been withdrawn from consideration 37 C.F.R. § 1.142(b). Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed claims and disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, including page 2, lines 19-20 of the present specification.

Claim 4 was objected to under 37 C.F.R. § 1.75(c), as allegedly being of improper dependent form. Applicants respectfully request reconsideration and withdraw of the objection in view of the foregoing amendment to claim 4, placing the claim in independent form.

Claims 1-2 and 6-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Turpin et al. (U.S. Patent No. 5,167,684, hereinafter "Turpin"), Berkey et al. (U.S. Patent No. 5,152,818, hereinafter "Berkey") and Yamauchi et al. (U.S. Patent No. 4,834,786, hereinafter "Yamauchi"). Applicants respectfully traverse the rejection.

Independent claims 1, 2 and 14 recite in pertinent part, that the second and third steps are performed on a drawing tower. Applicants submit that none of the references applied by the Examiner disclose or suggest drying one or more holes on inner wall surface of the preform on a drawing tower. The Examiner admitted that Turpin does not disclose a second step comprising

heating the perform, much less that both the second and third steps are performed on a drawing tower. Rather, on page 5 of the Office action, the Examiner asserts that it would have been obvious to have the drying step and the drawing step both performed in the drawing tower “so as to save the time/cost of transferring the perform - and to reduce the risk of dropping the perform and breaking it.” Applicants respectfully traverse.

It is well established that the factual question of motivation cannot be resolved on subjective belief of the Examiner and unknown authority, but must be based on objective evidence of record. *In re Lee*, F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Applicants submit that the Examiner's conclusory statements regarding the obviousness of the proposed combination is factually unsupported. The Examiner's asserted motivation for modifying Kirsten, which is "save the time/cost of transferring the perform - and to reduce the risk of dropping the perform and breaking it" and lack of factual support thereof comports very closely to the analysis disapproved by the Federal Circuit in *In re Lee*. The Examiner has not provided any factual basis that would lead one having ordinary skill in the art to believe that modifying the method of Turpin would somehow save time/cost and reduce risk of breaking the preform. As such, the Examiner's failure to provide factual support for a teaching, suggestion, or motivation to modify Turpin constitutes legal error. In the absence of any factual support, the Examiner merely offers an unsupported supposition of a fact to arrive at the alleged obviousness of the claimed subject matter. The Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged, as the factual predicate has not been satisfied and broad conclusory statements, standing alone, are not “evidence” supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

To the extent that the Examiner may be implicitly relying upon “official notice,” the Examiner may only take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well-known” in the art. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). Applicants request the citation of objective evidence to establish what the Examiner has asserted is well-known. Failure to provide objective evidence in the face of such a request constitutes grounds for reversal. *Ex parte Natale*, 11 USPQ2d 1222 (BPAI 1988); *Ex parte Nouel*, 158 USPQ 237 (Bd. App. 1967). The reason why Applicants request objective evidence to support the Examiner's assertions is that what may or may not be known in general does not provide the requisite motivation to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

In view of the above, it is submitted that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Withdrawal of this 35 U.S.C. § 103(a) rejection is requested.

Claims 1, 3, 5 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Patent No. 4,157,906, hereinafter “Bailey”). Applicants respectfully traverse the rejection. Applicants submit that Bailey, as seen in Figure 3, does not disclose or suggest an optical fiber having one or more holes extending along the fiber, as required in amended independent claims 1 and 3. Accordingly, Bailey fails to disclose or suggest every limitation of the claimed inventions, as recited in claims 1 and 3. Accordingly, the rejection of Claims 1, 3, 5 and 15 under 35 U.S.C. 103(a) should be withdrawn.

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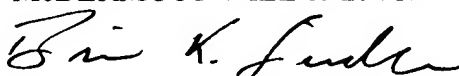
Independent claim 24 is free from the applied art since none of the references, alone or in combination discloses or suggest a manufacturing method of an optical fiber having one or more holes extending along the fiber and that the second step and third step are preformed on a drawing tower.

It is believed that the pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck

Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:idw
Facsimile: 202.756.8087
Date: March 21, 2005

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